

REMARKS

Reconsideration and allowance of this application, as amended, are respectfully requested.

The prior art grounds of rejection are traversed. Claims 19 and 24 are amended.

The rejection of claim 24 under 35 USC 102 as being anticipated by Moraes (US Patent No. 6,014,502) is respectfully traversed. The Examiner is referred to Moraes col. 5, lines 28-39:

“Whenever a user ... establishes a connection with the server system ... eligible advertisement can be transmitted from the server system to the client program and stored on a memory device....of the client computer”.

There are only two ‘parties’ interacting: the user and the server system. Moraes et al do not deal with mail transmitted from a sender to a recipient. Moraes et al do not disclose any relationship between the advertisement and the mail.

According to our claimed inventions, the mail server adds advertisement information to a mail, which is to be sent by a sender to a recipient. Three parties are involved: the sender, the recipient, and the mail server, as required by our claims 1, 10, 19, and 24.

Moraes et al provide no description of adding an advertisement to a mail message, which is to be sent from a sender to a recipient. Moraes et al do not disclose installing a program in a terminal for enabling the terminal to send a mail message, which is to be sent to a recipient mail address, to a mail server that adds the advertisement information to the mail as required by our claim 24, and a setting controller that sends “a program to the terminal, from which the adding request is received, so that the mail, which is to be sent to the recipient mail address from the terminal, is sent to the mail server that adds the advertisement information to the mail” as required by our claim 19. Thus our claims 19 and 24 are novel and unobvious over Moraes et al.

Claims 1-5 and 10-14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,360,221 to Gough et al in view of U.S. Patent Number 6,047,310 to Kamakura et al. and U.S. Patent Number 6,073,165 to Narasimhan et al. This ground of rejection is respectfully traversed.

The Examiner is urged to consider the portion of the Gough reference at col. 4, lines 1-21.

In the present invention, server machine 10 "hosts" an e-mail web site 11. A sender at sender machine 12 can "upload" or enter message content to the web site 11 through the Internet 16 as indicated at 13A. This is typically accomplished via a web browser on sender machine 12 "opening" the web site 11 on the server 10. The web site 11 then, under the guidance of the sender, "enhances" the message content and sends or "e-mails" the message to one or more recipient mail boxes as illustrated at 13B. In this instance, mail boxes 17A, 17B, etc. are hosted by an e-mail server machine 15 connected to the Internet 16. Such e-mail mailboxes are provided by a variety of vendors, including America On Line (AOL), Hotmail, etc. The recipient then accesses his or her mail box to receive the enhanced e-mail at the recipient machine 14 via the Internet 16 as indicated at 13C. Alternatively, if the recipient is a member of the web site 11, he or she can receive the e-mail directly from an e-mail box 19 on the server 10 as illustrated at 13D. As noted previously, some or all of the various processes, services, mail boxes, etc. may be distributed around the network 16, as will be appreciated by those skilled in the art.

This portion of the reference describes that a server machine 10 "hosts" an email web site 11. A sender at sender machine 12 can upload or enter message content to the web site 11 through the Internet 16 as indicated 13A.

Therefore, the user has to access the email web site 11 to send a mail in the system of Gough. An advertisement of "JOIN eSprinkles.com FREE!" is originally included in the home page 18 as shown in reference Fig. 2.'

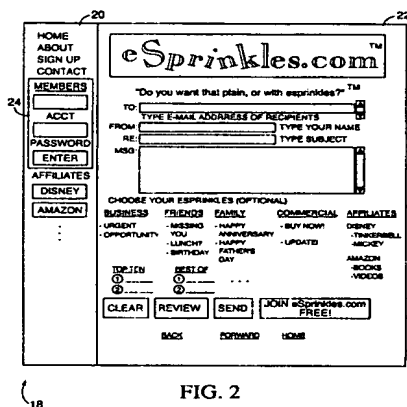


FIG. 2

The idea of *adding* advertisement information to the mail, which is to be sent to the recipient from the sender, is not disclosed in Gough et al. Gough does not teach or even suggest an advertisement information adding portion as required by our claims 1, 10, and 19. With regard to Kamakura (US Patent 6,047,310), the Examiner is referred to col. 4, lines 35-

57:

The inputting unit 1 inputs an information reception requirement and an information transmission requirement. The information reception requirement includes receiver attributes of a receiver and desired conditions of information to be transmitted. The information reception requirement is designated by the receiver. The information transmission requirement includes information attributes of information to be transmitted and desired conditions of a sender for receivers. The information transmission requirement is designated by the sender. When the information attributes satisfy the desired conditions for the information and the receiver attributes satisfy the desired conditions for the receivers, the processing unit 2 allows the distribution of the information from the sender to the receivers.

The receiver attributes and the desired conditions of the sender for the receivers are input to the information providing apparatus by the inputting unit 1. The processing unit 2 determines whether or not the receiver attributes accord with the desired conditions of the senders. The receiver attributes are attributes of receivers such as age, sex, and occupation. The sender inputs the desired conditions for these attributes. The

processing unit 2 can select receivers that satisfy the desired conditions of the sender.

Kamakura states: "The processing unit 2 can select *receivers* that satisfy the desired conditions of the sender". Thus, it is clear that the apparatus of Kamakura does not "select the advertisement" but selects receivers that satisfy the desired conditions. Kamakura does not teach or even suggest "an advertisement information detector" as required by our claims 1, 10, and 19.

The Narasimhan et al. (US Patent No. 6,073,165), reference is cited only for the purpose of explaining the term "SMTP server".


Claims 6-9 stand rejected under 35 USC 103 as being unpatentable over Gough et al in view of Kamakura et al and Narasimhan et al and further in view of US Patent No. 6,128,646 to Miloslavsky. This ground of rejection is respectfully traversed.

Miloslavsky discloses "extract appropriate information from the content of the e-mails" in column. 4, lines 19 - 20. However, Miloslavsky does not disclose "detects advertisement information that is associated with a key word" as required by our claim 6. Thus, Miloslavsky clearly does not disclose "the use of key words for *filtering advertisement*" as suggested by the Examiner. Thus, claim 6 is not rendered unpatentable by Miloslavsky, either alone or in combination with the other references.

The rejection of claims 19-23 under 35 USC 103 as being unpatentable over Gough et al in view of Moraes and Kamakura is respectfully traversed for the reasons set forth above. Furthermore, even if the teachings of Gough et al. (US Patent No. 6, 014, 502) and Kamakura (US Patent No. 6,047,310) were combined, the resulting arrangement that would be created by one of ordinary skilled in the art would be different from those defined by our claims which embody the idea of adding advertisement information appropriate for the individual characteristics of the sender or recipient, to one specific mail.

All matters having been attended to a Notice of Allowance for the pending claims is solicited.

Respectfully submitted,  
Pillsbury Winthrop LLP

By:   
Glenn J. Perry  
Reg. No.: 28458  
Tel. No.: (703) 905-2161  
Fax No.: (703) 905-2500

GJP/jjg  
1600 Tysons Boulevard  
McLean, VA 22102

(703) 905-2000

Enclosure: Appendix

APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

19. (Once Amended) A mail processing system comprising a web server operable to send a predetermined program to a terminal based on a request from the terminal; and a mail server operable to send a mail having a [predetermined] recipient mail address [as a] of an intended recipient to a server that receives and stores the mail [having the predetermined mail address as the recipient], wherein the mail server includes:

an advertisement information memory [operable to store advertisement information added to the mail to be sent;

an advertisement information detector operable to retrieve the advertisement information from the advertisement information memory that is to be added to the mail] operable to detect advertisement information to be added to the mail from the advertisement information memory based on at least one of: (a) user information about a user having the recipient mail address, (b) user information about a user having a sender mail address corresponding to a sender of the mail, and (c) a portion of a message in the mail ;

an advertisement information adding portion operable to add the advertisement information to the mail; and

a sending portion operable to send the mail to the server, wherein the web server includes:

a reception portion operable to receive an adding request of advertisement information to the mail from the terminal; and

a setting controller operable to [make a setting for allowing the mail to be sent by the mail server, by sending a program to the terminal from which the adding request is received] send a program to the terminal, from which the adding request is received, so that the mail,

which is to be sent to the recipient mail address from the terminal, is sent to the mail server that adds the advertisement information to the mail.

24. (Once Amended) A [web server for sending a predetermined program to a terminal based on a request from the terminal] method for enabling a terminal to send a mail, comprising:

[a reception portion operable to receive] receiving a request to add advertisement information to a mail from the terminal by a web server; [and]

sending a predetermined [a setting controller operable to send a] program to the terminal from which the adding request came [so that setting for enabling a mail server that adds the advertisement information to the mail to send a mail to a mail address of a recipient, is performed] ;and

installing the program in the terminal for enabling the terminal to send a recipient addressed mail to a mail server that adds the advertisement information to the mail.

End of Appendix